SONY 3.0-030
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Paul H. Feinberg

Group Art Unit: 3622

Application No.: 09/785,095

Examiner: Raquel Alvarez

Filed: February 16, 2001

For: SYSTEM AND METHOD FOR PROVIDING CUSTOMIZED ADVERTISEMENTS OVER A NETWORK

REPLY BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is submitted in response to the Examiner's Answer mailed September 6, 2006. The Brief is particularly directed to the section of the Examiner's Answer entitled "Response to Arguments," and to the Examiner's assertions regarding the Hall reference. (Examiner's Answer section 10).

In the Examiner's Response to Arguments, the Examiner acknowledges that Hall teaches "giving an indication to the service provider of the customer's time of arrival at the local facility." (Examiner's Answer section 10, lines 4-6). By contrast, each of Appellant's claims recite that the "customer" receives a message indicating a change in proximity of the "customer" relative to the "local facility."

The Examiner attempts to address Hall's deficiencies in her Response to Arguments by citing Hall's column 10, lines

7-13. More specifically, the Examiner points out that the cited portion teaches "the customer maintaining connection with the service provider system (SPAS 365) and updating periodically the customer's estimated time of arrival (ETA)" (Examiner's Answer section 10, lines 7-10), and asserts that "if the estimated time of arrival is being updated and sent to the service provider system (SPAS 365) and the customer can opt to stay in direct communication with the service provider (SPAS) then it would make sense for the service provider to pass the information to the customer." (emphasis supplied) (Examiner's Answer section 10 lines 11-14).

Appellant submits that Hall does not teach or suggest the service provider transmitting updated ETA data to the customer, and that such transmission only would only "make sense" in view of Appellant's disclosure.

A careful reading of Hall's column 10, lines 7-13 reveals that there is no teaching or suggestion that the updated ETA may be transmitted back to the customer. More specifically, column 10, lines 7-13 merely states:

> In an alternative embodiment, the customer may opt to maintain a connection with the SPAS 365 in which case PAA 220 may continue to transmit customer location information to SPAS 365. This customer location information may be used to update periodically the customer's ETA (Step 690).

(Hall column 10, lines 7-13).

In view of Hall's emphasis on communicating the customer's ETA to the service provider, one skilled in the art would not understand Hall's column 10, lines 7-13 to suggest transmitting the ETA back to the customer. Indeed, Hall

emphasizes "allow[ing] a service provider to receive customer location information from a location determination system and schedule an order from the customer to be completed by a local facility so that the order will be ready when the customer arrives." (Hall column 2, lines 44-48). Thus, Hall stresses the need for the service provider to know the customer's ETA so that the provider can have the customer's order ready upon the customer's arrival. Communicating the customer's ETA back to the customer would not help Hall meet its objective. Therefore, one skilled in the art who understands Hall's objective would not be motivated to modify Hall such that the customer's ETA is communicated back to the customer.

Furthermore, the Examiner's assertion that Hall inherently suggests communicating the customer's ETA back to the customer appears to be based on a hindsight reconstruction of Hall as viewed in light of Appellant's disclosure. Such hindsight reconstruction is impermissible. The law is well established that "[A] retrospective view of inherency is not a substitute for some teaching or suggestion which supports the selection and use of various elements in the particular claimed combination." *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989).

In sum, for the reasons set forth in the Appeal Brief and in this Reply Brief, it is respectfully submitted

that the Examiner erred in rejecting claims 1-48, and a reversal of such rejections by this Honorable Board is solicited.

Dated: November 1, 2006

Respectfully submitted,

By _____

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